

Macneale, 107 U.S. 90, 96-97 (1882); *Ex parte Kuklo*, 25 USPQ2d 1387, 1390 (Bd. Pat. App. & Inter. 1992); *In re Smith*, 714 F.2d 1127, 1134, 218 USPQ 976, 983 (Fed. Cir. 1983); MPEP 2133.03(a). In order for a claim to be invalid for being “on sale” under 35 U.S.C. 102(b), a sale or offer to sell must have occurred more than one year before the filing date of the application, the subject matter of the sale anticipates or renders obvious the claimed invention, and the invention was ready for patenting. *Ferag AG v. Quipp, Inc.*, 45 F.3d 1562, 1565, 33 USPQ2d 1512, 1514 (Fed. Cir. 1995); *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 67, 48 USPQ2d 1641, 1646-47 (1998); MPEP 2133.03(b).

Applicant respectfully submits that this criteria is not met here.

Claim 1 of the present application recites:

A method of responding to a request, the method comprising the steps of:
 establishing a plurality of categories of potential requests;
 associating a plurality of sets of data with each of the categories; and,
 in response to receipt of a request, relating one of the categories to the request and preparing a response including at least two sets of data from the related category.

The references cited by the Examiner in support of the 102(b) rejection do not describe the Audiohighway.com service as performing the steps of claim 1 of the present application. The cited references merely note that Audiohighway.com’s service is funded by “personalized advertisements.”

As described in the attached Rule 1.132 declaration by the inventor, Ted Richards, prior to August 1999, the personalization features provided by Audiohighway.com used a “user profile,” which had previously been submitted by the user, to provide the “personalized advertisements.” The advertisements were not selected based on a category of a request from the user or a category of a selection from the user.

In contrast to the user profile approach, claim 1 recites a method where a response to a request is prepared based on relating the request, not a user profile, to a category of requests and including data in the response from the related category. Thus, the subject matter which was “on sale” or “publicly used” by AudioHighway.com prior to August 1999 does not anticipate or render obvious claim 1 of the present application.

Claim 5 of the present application recites:

A method for providing user information related to a user’s

selection of audio data, the method comprising the steps of:
 receiving a user's selection of audio data and an
indiciium identifying the user;
 analyzing the user's present selection of audio data and
previous selections, if any, of audio data, and identifying at
least one user interest category based on the user's present and
previous audio data selections;
 selecting at least one user information item from the at
least one identified user interest category;
 associating or combining the at least one user
information item with the user's audio data selection; and
 delivering the associated or combined at least one user
information item and the user's audio data selection to the user
over an electronic network.

The method of claim 5 also does not use a user profile to select an information item for delivery to the user, but rather bases the selection of the information item on the user's present audio data selection and previous audio data selections (if any). Thus, the subject matter which was "on sale" or "publicly used" by AudioHighway.com prior to August 1999 does not anticipate or render obvious claim 5 of the present application.

Claim 10 of the present application recites:

A system for responding to a request, the system comprising:
 a store for data organized in a plurality of categories
each including a plurality of sets of data; and
 means responsive to receipt of a request for relating one
of the categories to the request and preparing a response
including at least two sets of data from the related category.

The system of claim 10 also does not use a user profile to select sets of data for delivery to the user, but rather relates a user's request to a data category and prepares a response including at least two sets of data from the related category. Thus, the subject matter which was "on sale" or "publicly used" by AudioHighway.com prior to August 1999 does not anticipate or render obvious claim 10 of the present application.

Claim 12 of the present application recites:

A system for responding to a request, the system comprising:
 a store for data organized in a plurality of categories
each including a plurality of sets of data;
 means for archiving successive requests from a given
requester; and
 means responsive to receipt of a new request from the
same requester for relating one of the categories to an archived
request and the same or a different category to the new request

and preparing a response including at least two sets of data from at least one related category or at least one set of data from each of at least two related categories.

The system of claim 12 also does not use a user profile to select sets of data for delivery to the user, but rather relates a new request and an archived request of the user to at least one data category and prepares a response including at least two sets of data from the related categories. Thus, the subject matter which was “on sale” or “publicly used” by AudioHighway.com prior to August 1999 does not anticipate or render obvious claim 12 of the present application.

Claim 14 of the present application recites:

A system for providing user information related to a user's selection of audio data, the system comprising:
an audio data server that receives a user's selection of audio data and an indicium identifying the user;
a user information server that analyzes the user's present selection of audio data and previous selections, if any, of audio data, that identifies at least one user interest category based on the user's present and previous audio data selections that selects at least one user information item from the at least one identified user interest category, and that associates or combines the at least one user information item with the user's audio data selection; and
an audio data delivery system that delivers the associated or combined at least one user information item and the user's audio data selection to the user over an electronic network.

The system of claim 14 also does not use a user profile to select an information item for delivery to the user, but rather bases the selection of the information item on the user's present audio data selection and previous audio data selections (if any). Thus, the subject matter which was “on sale” or “publicly used” by AudioHighway.com prior to August 1999 does not anticipate or render obvious claim 14 of the present application.

Since claims 2 to 4, 6 to 9, 11, 13, and 15 to 21 are dependent on claims 1, 5, 10, 12 or 14, they also cannot be properly rejected under 35 U.S.C. § 102(b) as being “on sale” or in “public use” more than one year before the filing date of the present application.

Thus, it is respectfully submitted that the rejection of claims 1 to 21 under 35 U.S.C. § 102(b) should be withdrawn.

Conclusion

It is respectfully submitted that the application is in condition for allowance, and Applicant requests reconsideration and withdrawal of all grounds of rejection.


A Notice of Allowance is respectfully requested.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. §1.16 or §1.17 to Deposit Account No. 11-0600.

The Examiner is invited to contact the undersigned at (212) 425-7200 to discuss the application.

Respectfully submitted,

Dated: 8/27/03

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